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| APPLICATION NO.           | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.  | CONFIRMATION NO. |
|---------------------------|-------------|----------------------|----------------------|------------------|
| 10/791,688                | 03/01/2004  | Jeffrey Bergh        | 129843.1082 (H.072A) | 2600             |
| 60148                     | 7590        | 04/09/2009           | EXAMINER             |                  |
| GARDERE / JHIF            |             |                      | KENNEDY, JOSHUA T    |                  |
| GARDERE WYNNE SEWELL, LLP |             |                      |                      |                  |
| 1601 ELM STREET           |             |                      | ART UNIT             | PAPER NUMBER     |
| SUITE 3000                |             |                      |                      | 3679             |
| DALLAS, TX 75201          |             |                      |                      |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/791,688             | BERGH ET AL.        |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | JOSHUA T. KENNEDY      | 3679                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 04 March 2009.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 79-89 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 79-89 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

Claims 1-78, 90 and 91 have been cancelled.

Claims 79-89 have been examined.

### ***Claim Objections***

Claims 80-86 and 89 are objected to because of the following informalities:

These claims all directly depend from cancelled claim 1. For this Office action only, these claims will be presumed to depend from claim 79. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 79-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caceres et al in view of Gleeson et al and Newberry.

As to Claim 79, Caceres et al disclose a fencing system comprising:

an elongated member (13) having at least a front surface and a back surface (20); and

a pattern provided on each of the front surface and the back surface of the elongated member (Col 3, Lines 32-33) wherein the pattern is consistent and is capable of being repeated on each of the front surface and the back surface of the elongated

member (Examiner considers the pattern to be “capable of” being repeated. For example, a flat surface/pattern/texture is easily repeated on the front and back surfaces).

However, Caceres et al do not disclose the elongate members comprising fiber cement having fibers, wherein the fiber cement forming the elongated member incorporates a low-density additive such as micro spheres or volcanic ash as well as moisture resistant cellulose fibers

Gleeson et al teach a fiber cement building material having cellulose fibers having low density additives of volcanic ash, microspheres or a combination thereof added to moisture resistant cellulose fibers that has “applicability to a number of building product applications, including but not limited to building panels, tie backer board... fencing, and decking” (Par. 107, Lines 1-5). Examiner notes that the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the plurality of individual members of Caceres to be constructed of the fiber cement building material as taught by Gleeson et al because of its applicability to a number of building product applications, including fencing and it’s a lightweight material with “workability at an economical price, as well as improved dimensional stability” (Par. 10) such as a lowered density of the material, yielding expected and predictable results.

Further, Caceres et al do not disclose the pattern being provided using a plurality of rollers, wherein each roller has a textured surface and is adapted to turn at a predetermined speed relative to the elongated member to achieve a high fidelity transfer of the pattern to the front surface and the back surface of the elongated member wherein the pattern is formed of the same material as the elongated member. Examiner notes that the specific method of forming is not germane to the issue of patentability of the device itself. Therefore, the limitation “the pattern being provided using a plurality of rollers, wherein each roller has a textured surface and is adapted to turn at a predetermined speed relative to the elongated member to achieve a high fidelity transfer of the pattern to the front surface and the back surface of the elongated member wherein the pattern is formed of the same material as the elongated member” has been given only limited patentable weight and does not serve to structurally distinguish the claims. See MPEP § 2113. Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. *In re Klug*, 333 F.2d 905, 142 USPQ 161 (CCPA 1964). In an ex parte case, product by process claims are not construed as being limited to the product formed by the specific process recited. *In re Hirao et al.*, 535 F.2d 67, 190 USPQ 15, see footnote 3 (CCPA 1976).

Assuming arguendo that the pattern would not be consistent nor repeatable, Newberry Jr. teaches a similar fencing system having each component formed using the same material in a mold impression of a fence component. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify

the fencing system of Caceras et al to have the exterior pattern being formed of the same material as the elongated member as taught by Newberry Jr. to more easily reproduce the surface of the panel desired (Col 4, Lines 37-44) without the requirement of an additional process step or additional materials, yielding expected and predictable results. It is also noted that it has been consistently held that change in ornamental design having no mechanical function is an aesthetic design consideration within the skill of the art. In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

As to Claim 80, it is noted that the limitation of “wherein the elongated member is cut to size and shaped for use in the fence system prior to curing the fiber cement, wherein the elongated member does not exhibit any substantial fraying of the fibers along the surfaces of the elongated member after curing” imparts limited patentable weight to the invention and that it is the patentability of the product, and not recited process steps, that is to be determined in product-by-process claims irrespective of whether or not only process has been recited. Accordingly, it is of little consequence how the surfaces features formed or how the members are sized and shaped when all features and structure are present. See MPEP § 2113. The claimed structure matter appears to be met by the rejection, above, and therefore it has been held that if the product defined in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made from a different process. See In re Thorpe, 77 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985).

As to Claim 81, Caceres et al disclose a fencing system wherein the elongated member has at least one surface that has a pre-finish thereon (Col 3, Lines 32-33).

As to Claim 82, Caceres et al disclose a fencing system wherein the elongated member resembles a picket (Fig 1).

As to Claim 83, Caceres et al disclose a fencing system wherein the elongated member has an upper end, wherein the upper end is formed into a shape selected from the group consisting of square cut, dog-eared, French gothic, scalloped, pointed and saw-toothed (Fig 1).

As to Claim 84, Caceres et al disclose a fencing system wherein the front surface and back surface of the elongated member has a finish that resembles wood (Col 3, Lines 34-35).

As to Claim 85, Caceres et al disclose the fencing system significantly as claimed, but do not explicitly disclose the front surface and back surface of the elongated member has a finish that resembles masonry.

Newberry Jr. teaches a similar fencing system having “the general appearance of stone...fences” (Col 1, Lines 46-47). Newberry Jr. does not disclose any structural or functional significance as to the aesthetic appearance of the fence and Examiner notes that a change in ornamental design having no mechanical function is an aesthetic

design consideration within the skill of the art. In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). Accordingly .it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the fencing system of Caceres et al to have the appearance of masonry, as taught by Newberry, Jr. as the reference does not disclose any structural or functional significance as to the exterior appearance of the fence as this is merely an aesthetic design choice yielding expected and predictable results.

### ***Response to Arguments***

Applicant's arguments filed 3/4/2009 have been fully considered but they are not persuasive.

Applicants argue:

"Caceres does not disclose or suggest fencing components made of fiber cement, or the use of a pattern, or a pattern formed of the same material as its fence component. Caceres discloses that its fiberglass fence component may have a texture by using a structural support material - "resin impregnated reinforcing fiber mesh" - which is incorporated into the underlying components and drawn through the shaping die. See Caceres Col. 3, lines 29-38. Given the nature of the fiber mesh/scrim material, this material would be randomly dispersed within the fence component and would not form a pattern consistent and repeatable on opposing sides of the fiberglass fence component" (Pages 5-6)

Examiner respectfully disagrees. As to the recitation that the pattern is "repeatable", it should be noted that the suffix "-able" indicates in English that the word so modified is "capable of". Consequently, repeatable merely denotes that the pattern can be but is not required to be repeated. Thus, that some pattern may be "repeatable" relates to a situation which may very well never be and which is not required by the express claim

language. Nevertheless, as advanced above, the Examiner considers the pattern to be "capable of" being repeated. For example, a flat surface/pattern/texture is easily repeated on the front and back surfaces. It should also be noted that it has been consistently held that change in ornamental design having no mechanical function is an aesthetic design consideration within the skill of the art. In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

Applicants further argue:

"Given that two separate molds are required (produced with numerous irregularities as described above), one of skill in the art would not expect to produce a pattern that is "consistent and repeatable ....on each of the front surface and the back surface" of the fiberglass fencing panel, resulting in a "high fidelity" pattern" (Page 6)

Examiner respectfully disagrees. Assuming arguendo that the components of Caceras are not repeatable, it is the nature of a mold in general, such as the one presented in Newberry, to consistently repeat a desired pattern or design onto a fence panel regardless of minor blemishes or irregularities. Again it is noted that it has been consistently held that change in ornamental design having no mechanical function is an aesthetic design consideration within the skill of the art. In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

Applicants should also note that in a product-by-process claim, it is the patentability of the product and not the recited process steps that is to be determined. In re Thorpe et al, 227 USPQ 964 (CAFC 1985). Thus, how one goes about providing

the pattern is of little consequence when a pattern is present in the prior art. Moreover, rollers are not a “fencing system” element and have not otherwise been positively included in the claim as claim 79 is drawn solely to an elongated member having a pattern. Reciting that rollers are used to provide the pattern is nothing more than the recitation of a process step on the formation relating to the elongated member with pattern.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA T. KENNEDY whose telephone number is (571)272-8297. The examiner can normally be reached on M-F: 7am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Joshua T. Kennedy/  
Examiner, Art Unit 3679  
3/30/2009

/Daniel P. Stodola/  
Supervisory Patent Examiner, Art Unit 3679